

Application No. : 10/665,213
Art Unit : 3744

Attorney Docket No. 22461.00
Confirmation No. 5730

REMARKS

By the present amendment, Applicant proposes to amend Claims 1, 6, 12 and 15, and cancel Claims 7-10 and 16-17. Upon entry of the proposed amendment, Claims 1-6, 11-15 and 18-20 will remain pending in the present application. Claims 1, 6 and 15 are independent claims.

Applicant herein respectfully requests an interview with the Examiner to discuss the merits of the present invention in accordance with MPEP § 713.01. Due to the unavailability of the Examiner, Applicant's representative was unable to schedule an interview prior to the expiration of the extended period for response. Applicant respectfully requests that the Examiner consider the effect of the present amendment and defer taking any further action in this case until an interview can be arranged.

In the recent Office Action the Examiner rejected Claims 1, 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. (U.S. Patent No. 6,382,469) in view of Lacoste (U.S. Patent No. 5,882,042) or Trachtenberg (U.S. Patent No. 6,446,453). Claims 2, 3, 6-8, 10-15 and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. in view of Lacoste or Trachtenberg, and further in view of Goncalves (U.S. Patent No. 4,513,890) or Gross (U.S. Patent No. 6,269,986). Claims 9 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Carter et al. in view of Lacoste or Trachtenberg.

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The claims have been amended to more particularly define the preferred embodiments of the presently disclosed invention. Applicant will advance arguments herein below to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Independent Claims 1 and 6 have been amended to positively recite – a refrigerant discharge hose—. The discharge hose is defined as comprising an elongate tubular body having a receiving end and a discharge end, wherein the receiving end includes a threaded fitting removably attached to the threaded projection of the actuator cap, and the discharge end includes a disconnect coupler fitting for engaging a vehicle air conditioning unit. Amended independent Claim 15 stipulates that the refrigerant hose is removably secured to the threaded projection of the actuator cap. This removable feature allows the hose to be re-used with new canisters. Otherwise, a new hose would be needed every time a new canister was used. Applicant contends that the combination of references relied upon of record fails to disclose or reasonably suggest a an actuator for dispensing the pressurized contents of a canister having the combination of structural and functional features as defined by the present claims.

As noted of record, the primary reference to Carter et al. (U.S. 6,382,469) fails to disclose a threaded connection between the discharge tube and the actuator. Clearly, there appears no suggestion in Carter et al. that the discharge tube may be removable and re-used with new

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pressurized containers as set forth by the present claims. While this reference suggests that the disclosed actuator may be used with freon containers, there appears no disclosure as to how this freon dispensing application can be achieved. Applicant describes under the present specification at page 2 that certain unique problems are associated with adding refrigerant to an automobile air conditioning unit, which are wholly unrelated to tire inflation. Thus, one of ordinary skill in the art would not necessarily find dispensing tubes for tire inflation and discharge tubes for refrigerant applications to be equivalent.

In order to supplement the apparent deficiencies of the primary reference, the Examiner relies upon the secondary references to Lacoste or Trachtenberg. The patents to Lacoste and Trachtenberg disclose threaded connectors at one end of a refrigerant line. The Examiner thus concludes that it would be obvious to one of ordinary skill in the art to provide the apparatus of Carter et al. with the threaded connectors as taught by Lacoste or Trachtenberg. Notwithstanding the Examiner's conclusion of obviousness, it is apparent that the patent to Carter et al. is concerned with a tire inflation actuator that is "capable of being easily manufactured without complex assembly of various components." This reference further states the one-piece integrally molded actuator is "simply mounted on the container 12 after assembly with the discharge tube 24" See Col. 9, lines 53-61. Clearly, one skilled in the art would not be motivated or guided by the prior art to substitute complex threaded connectors taught by either Lacoste or Trachtenberg for the discharge tube of Carter et al. since such a modified construction would defeat the expressed intentions of

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the primary reference in terms of increased costs of manufacture.

Further, the combined teachings afforded by Carter et al. and Lacoste/Trachtenberg fail to suggest a hinged lid as presently disclosed and claimed. Applicant contends that the Examiner's reliance upon the Goncalves or Gross references do not provide suitable teaching that would have taught one skilled in the art to arrive at the present invention for the reasons as argued of record.

Applicant notes that a rejection based on 35 U.S.C. 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not because of doubts as to the patentability of the invention, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.* In this vein, the examiner may not rely on so-called mechanical or per se rules of obviousness to sidestep the fact specific analysis of claims and prior art that is required by 35 U.S.C. 103(a). *In re Ochiai*, 71 F.3d 1565, 1570-71, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1995); *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965).

As this court has stated, "virtually all [inventions] are combinations of old elements." (*citations omitted*). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together

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elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensoronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (*Emphasis added*).

In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at 1457-58.

In the present case, the Examiner's conclusion that the invention defined by the present claims would have been obvious within the meaning of 35 USC 103(a) rests on a series of unsubstantiated assertions concerning the prior art in general and the Carter et al., Lacoste/Trachtenberg and Goncalves/Gross references in particular. The mere fact that the prior art may be modified in the manner proposed by the Examiner does not make the modification obvious absent a suggestion in the prior art of the desirability to do so. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The patent to Carter et al., the primary reference proffered by the Examiner to support the rejection of the claims, is completely devoid of any suggestion of an actuator having a hinged lid or a refrigerant hose that is removably attached to the threaded projection as called for by the present claims, or any mention of the

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functional advantages such claimed features as disclosed under the specification.

Applicant contends that one skilled in the art would not be motivated to combine the references in the manner suggested by the Examiner. Applicant further contends that even if the references were properly combinable, the above noted deficiencies of the primary reference to Carter et al. are not remedied by the teachings afforded by the secondary references. Thus, one of ordinary skill in the art without the benefit of Applicant's own disclosure would not be capable of arriving at the presently claimed invention by combining the references in the manner suggested by the Examiner since none of references cited or applied of record realistically suggests the essential combination of features that forms the basis of the instant claims.. For at least these reasons, Applicant respectfully submits that independent Claims 1, 6 and 15, as amended, and corresponding dependent Claims 2-5, 11-14 and 18-20 are allowable over the prior art of record.

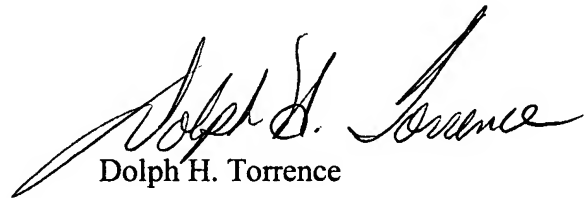
Applicant respectfully submits that the proposed amendments made herein properly respond to the outstanding Final Rejection and represent a *bona fide* effort to satisfactorily conclude the prosecution of this application.. Care has been exercised to ensure that no new matter has been introduced and that no new issues have been raised that would require further consideration or search. In the event that the application is not allowed, it is requested that this amendment be entered for purposes of appeal.

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For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Dolph H. Torrence', with a long, sweeping horizontal stroke extending to the left.

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Attachments